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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,658	11/28/2000	Matt Crosby	DIGIP016	7713
7590 01/29/2008				
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EXAMINER				
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ART UNIT		PAPER NUMBER		
2628				
MAIL DATE		DELIVERY MODE		
01/29/2008		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MATT CROSBY, DAVID C. WILKINS,  
and WILLIAM McCOY

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Appeal 2007-2855  
Application 09/724,658  
Technology Center 2600

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Decided: January 29, 2008

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Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and  
MAHSHID D. SAADAT, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-35, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method and apparatus for selectively processing a digital image that allows a user to rasterize an image at any desired resolution on-demand (Specification 1).

Independent claim 1 is representative and reads as follows:<sup>1</sup>

1. In a distributed system having a first node coupled to a first output device and a second node coupled to a second output device, a method of processing low resolution image object included in an associated high resolution image object file at the first node so as to provide on-demand rasterization appropriate for the second output device, comprising:

associating a state information file to the high resolution image object file whereby the state information file comprises an edit list having an embedded edit list and an external edit list wherein the external list comprises links to a plurality of assets that may be embedded in the resulting low resolution image object;

forwarding the low resolution image object and the associated state information file to the second node;

appropriately rasterizing the low resolution image object based upon the second output device as needed; and

outputting the appropriately rasterized image object at the second output device.

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<sup>1</sup> The text of claim 1 included in our decision is different from that of the Claim Appendix in Appellants' Brief in that it includes the changes made to claim 1 in the Amendment filed December 7, 2005 and was entered by the Examiner on December 21, 2006.

The Examiner relies on the following prior art references in rejecting the claims:

Phillips	US 6,215,485 B1	Apr. 10, 2001 (filed Apr. 3, 1998)
Yokomizo	US 6,522,418 B2	Feb. 18, 2003 (filed May 12, 1998)

The Examiner rejected claims 1-10, 13-25, and 28-35 under 35 U.S.C. § 103(a) as being unpatentable over Yokomizo and claims 11, 12, 26, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Yokomizo and Phillips.

We reverse.

### ISSUE

The issue on appeal turns on whether a preponderance of the evidence before us shows that, under 35 U.S.C. § 103, Yokomizo or its combination with Phillips teaches or suggests the claimed subject matter. Specifically, Appellants and the Examiner disagree as to whether Yokomizo discloses or suggests sending the edit list from the first node to the second node and using the list to rasterize the low-resolution image.

### FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issue before us and are believed to be supported by a preponderance of the evidence.

1. Yokomizo discloses a flowchart in Fig. 4 showing the process in which edition and printing of images are automatically performed in a

dealer branch shop in accordance with the editorial information which is indicative of the editing effected on the image and which has been automatically downloaded from the dealer HQ shop to the dealer branch shop. (Col. 10, ll. 62-67).

2. The data automatically downloaded from the dealer HQ shop 5 to the branch shop 1 consists of the “editorial information” 33 alone, which does not contain the image data. (Col. 11, ll. 1-4).

3. The computer of the dealer branch shop 1, upon receipt of the “editorial information,” operates to link the editorial information with the “*high-resolution image for printing*” which has been stored in the database of the branch shop 1, and performs *rasterization* and the required image processing such as red-eye processing 41, followed by printing performed by the printer P. (Col. 11, ll. 7-14) (emphasis added).

4. Yokomizo in Fig. 5 provides a flowchart showing the flow of the whole image processing explained before in connection with Figs. 2-4 and a basic service which will be described later. In Fig. 5, low-resolution proxy images and thumbnail images uploaded from the branch shop are inclusively denoted by 51. These images are referred to from the homepage 30 of the web server 9. (Col. 11, ll. 15-21).

5. The user can optionally use a digitize service as the results of the service are delivered to the user at, for example, the dealer branch shop, in the form of a high-definition image 3 stored in a CD-R 50. Service is also available for reading and editing images contained in a CD-R brought by the

user to the shop, uploading the same in the web server 9 or printing the same by means of the printer P. (Col. 11, ll. 22-29).

6. The user, in addition to purchasing the special application for editing, may conduct the editorial processing by using a Java applet or plug-in device downloaded to his computer through “proxy edition.” The user's machine (local machine) downloads a low-resolution image from the HQ shop of the dealer and affects various editorial processing on this image. The local machine then transmits the script of *the editorial results alone* to the machine of the dealer branch shop which serves as the server machine. The machine of the branch shop then *effects an editorial work in accordance with the above-mentioned script on the high-resolution image* which has been read and stored in this branch shop. Thus, the high-resolution image which has been prepared for the printing is edited in accordance with the user's request. (Col. 12, ll. 45-65).

7. As shown in Fig. 8 of Yokomizo, the proxy editorial plug-in device 73 provided on the client's end is similar to so-called image editing application and possesses functions for displaying templates, editing and importing of files, in addition to basic editorial functions *to be effected on low-resolution images*. In contrast, the proxy editorial software 84 at the server's end operates as a backstage function which supports the proxy editorial plug-in device 73 of the client's end. (Col. 14, l. 57 through col. 15, l. 2).

8. Yokomizo discloses the flow of the basic process in Fig. 10 wherein the process begins with the action of the user to bring the exposed

film 10-1 to a shop 10. In the shop 10, the images on the film 10-1 is read by means of a scanner (S) 10-2, whereby a high-resolution images 10-5 to be used for printing are obtained, as well as low-resolution proxy images 10-4 for the display purpose and thumbnail images 10-3 for retrieval purpose. These images are stored in the storage device installed at the shop 10. The low-resolution thumbnail images 10-3 and the proxy images 10-4 are sent as required to a HQ shop 20 or to the user and are stored as display images 20-1, 30-1. (Col. 18, ll. 32-44).

9. The user can download these low-resolution image data from the head office 20 or from the branch shop 10 through a communication line 20-5 or 30-6 or obtain the low-resolution image data in the form of data stored in a CD-R 35 prepared at the branch shop 10. The user can put the low-resolution images on the display 30-5 of the user's computer and can give desired image editorial instructions. The image on the display 30-5 is changed in accordance with the editorial instructions so that the user can confirm the result of the edition. (Col. 18, ll. 45-55).

10. The user gives desired editorial instructions 30-5 or 30-6 by using, for example, the editorial kit, while monitoring the proxy imaged displayed on the display unit 30-5, which are sent to the HQ shop 20 or the branch shop 10. When the editorial instructions have been received by the HQ shop 20, such instructions alone are transferred to the branch shop 10. (Col. 19, ll. 1-12).

11. The branch shop effects editing on the high-resolution image 10-5 in accordance with the received editorial instructions, and produces

print output 10-9 by means of the printer 10-8. The print output is delivered to the user when he visits the shop 10 or by way of mail. (Col. 19, ll. 9-13).

## PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). “[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (citing *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. “Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.” *In re Warner*,



379 F.2d 1011, 1017 (CCPA 1967). *See also In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

## ANALYSIS

In the Final Rejection, the Examiner reads the recited edit list on Yokomizo's proxy editorial plug-in device of the client's end: "The proxy editorial software performs functions such as the automatic generation of homepage, downloading of image files and templates from the server's end as requested by the client and access to the database for information from the server's end through the CGI program; e.g., column 14, lines 36-67; column 15, lines 1-23." (Final Rejection 3-4). In the Answer<sup>2</sup>, the Examiner appears to have further found that in Yokomizo the editorial functions on low resolution image on the client's end (Ans. 4-5) and the low resolution thumbnail image or proxy image forwarded to the client through downloading or through delivery of CD-ROM of Yokomizo is the same as the recited low resolution image and the associated state information that is forwarded to the second node and rasterized (Ans. 5). Further, the Examiner equates the recited "appropriately rasterizing the low resolution image object based upon the second output device as needed" to the basic editing functions in col. 14 and asserts that "rasterization" includes red-eye processing shown in Figs. 5-6 ("It is noted in column 11, lines 6-15 the rasterization can also be performed at the server's end on the high-resolution image based on red-eye processing") (Ans. 5).

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<sup>2</sup> "Corrected Examiner's Answer," mailed January 16, 2007.

Appellants' arguments in response to the obviousness rejection of appealed independent claim 1 assert a failure by the Examiner to establish a prima facie case of obviousness since, even if proper reasoning for one of ordinary skill in the art to modify Yokomizo were established, all of the claimed limitations would not be taught or suggested by the applied prior art reference. In particular, Appellants have taken issue with the foregoing findings by arguing that in Yokomizo, the edit list is sent from the second node to the first node and used to print the high-resolution image whereas the claims require the high-resolution image and the edit list be located at the first node and the edit list along with the low-resolution image be sent to the second node where they are rasterized (Br. 5). Appellants take the Examiner's position as characterizing the branch shop 10 as the second node and argue that the edit list received in the branch shop is used to rasterize the high-resolution image (*id.*).

The Examiner responds to Appellants' arguments by stating that the client's end in Yokomizo is the second node while the server's end meets the claimed limitation of the first node (Ans. 16). The Examiner further asserts that editorial functions performed by the proxy editorial plug-in device 73 and supported by the proxy editorial software 84 on the server side provide the state information file (*id.*). The Examiner further points out that when the client receives a low-resolution image and the editorial information from the server's end, the proxy editor plug-in device 73 is used for presenting the low resolution image, which is the same as rasterizing the low-resolution image at the client's end (*id.*).

Appellants contend that the downloadable templates mentioned in Yokomizo are actually used to provide a layout for one or more low-resolution images and are different from the claimed state information file associated to the high-resolution image object (Reply Br. 4). Appellants assert that the editorial functions may be downloaded to a client from a server or may be purchased in the form of an editorial kit (Reply Br. 5). Appellants argue that this is different from the claims since in Yokomizo, the user edits a low-resolution image and the edits are then returned back to a server for application to a high-resolution image (*id.*).

After reviewing the disclosure of Yokomizo in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Briefs. While claim 1 requires a state information file comprising an edit list and forwarding the low-resolution image object and the associated state information file to the second node, the claim does not specify the location where the state information is forwarded from. Therefore, if the client is considered as the second node, the Examiner's characterization is reasonable only to the extent that a state information file comprising an edit list is forwarded to the second node. However, as argued by Appellants *supra*, and for the reasons stated below, this state information is neither associated to the high-resolution image object file, nor used in rasterizing the low-resolution image object, as required by the claims.

Yokomizo keeps a high-resolution image file in the branch shop 1 which is edited based on the editorial file downloaded from the Head Quarter (HQ) shop 5 and rasterized before being sent to a printer for printing

the images (FF 1-2). Even if the client, as the second node, receives a low-resolution image along with the editorial software from the HQ shop or via a CD-ROM in Fig. 5, the script of the editorial results are sent back to the HQ shop and forwarded to the branch shop to be used for rasterization of the high-resolution image in the branch shop (FF 3-7).

Contrary to the Examiner's position that the editorial functions available to the user on the client's end and the low-resolution images used for performing editing functions on the user's computer (Ans. 16-20), the only rasterization disclosed in Yokomizo is performed on the high-resolution image in the branch shop (FF 3, 6, and 8). Although the proxy editorial plug-in device 73 on the client's end is used to edit the low-resolution image provided to the user's computer (FF 7), no rasterization takes place on the client's end. The low-resolution images are used for creating the editorial instructions that are sent back to the HQ shop and forwarded to the branch shop to be used for editing the high-resolution image stored in the branch shop and producing print outputs via a printer (FF 8-11).

We have also reviewed the Phillips reference, applied by the Examiner to address the claimed feature related to wirelessly transmitting the image object and the associated state file. However, we find nothing in Phillips which overcomes the deficiencies of Yokomizo in disclosing the specifically claimed sending the edit list from the first node to the second node and using the list to rasterize the low-resolution image.

#### CONCLUSION

Therefore, based on the evidence of record before us, and in view of the above discussion, we are of the opinion that the applied prior art reference, even if modified, does not support the obviousness rejection. We, therefore, do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 1-10, 13-25, and 28-35 over Yokomizo, nor of claims 11, 12, 26, and 27 over Yokomizo and Phillips.

#### DECISION

The decision of the Examiner rejecting claims 1-35 under 35 U.S.C. § 103 is reversed.

#### REVERSED

tdl/gvw

Appeal 2007-2855  
Application 09/724,658

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